

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

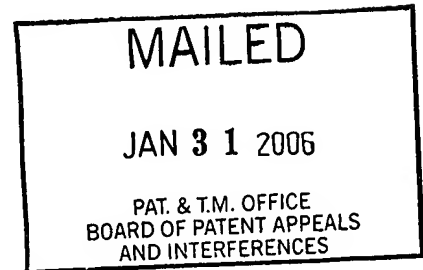
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANDREA MICHALIK

Appeal No. 2006-0098
Application No. 10/023,357

VACATUR AND REMAND



Before SCHEINER, ADAMS, and GRIMES, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

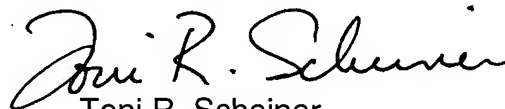
This appeal involves plant patent Application No. 10/023,357, filed December 17, 2001, which discloses and claims a variety of geranium plant named 'Penjul'. The question raised in this appeal is whether the foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabling printed publication disclosing the plant, thereby creating a patentability bar under 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004) and held in the affirmative (id. at 1128, 72 USPQ2d at 1041), with the proviso that "[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id. at 1131, 72 USPQ2d at 1043. Noting that the record in Elsner did not provide evidence regarding the nature or accessibility of the foreign sales, or whether "those sales [would have] enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation" (id.), the court vacated the Board's decision and remanded the case for "further factual

findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold" (*id.*).

In the present case, the examiner relies upon appellant's admission that the claimed plant - 'Penjul' - was on sale in Germany as early as March 1, 1999 as evidence that European Community Plant Breeders' Rights (PBR) Application No. 98/1667 (published February 15, 1999) constitutes an enabling reference. However, as in Elsner, there is no evidence of record establishing whether sales of the plant were of the type that would have been noticed by those of skill in the art. Nor is there evidence of record establishing whether the sales would have enabled one skilled in the art to reproduce the claimed plant without undue experimentation.

Accordingly, we vacate the examiner's rejection and remand the case to the examiner to determine (1) whether or not the sale of the variety of geranium named 'Penjul' was an obscure, solitary occurrence that would have gone unnoticed by those skilled in the art, and (2) whether possession of the claimed plant would have enabled one skilled in the art to reproduce the plant without undue experimentation.

VACATED; REMANDED



Toni R. Scheiner
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge

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